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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,178	06/20/2003	J. Kirk Haselden	MSFT-1741 (301923.01)	9748
41505 7590 07/11/2008 WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION) CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891				
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VU, TUAN A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/600,178

Applicant(s)

HASELDEN ET AL.

Examiner

Tuan A. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 15-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-10, 15-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the Applicant's response filed 5/02/08.

As indicated in Applicant's response, claims 1, 10, 15, 21 have been amended. Claims 1-10, 15-22 are pending in the office action.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a "useful, concrete, and tangible result" be accomplished. An "abstract idea" when practically applied is eligible for a patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The test for practical application is thus to determine whether the claimed invention produces a "useful, concrete and tangible result".

3. Claims 21-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 21 recites a computer system comprising means for determining and merging. From the specifications, this merging is a software module (e.g. Fig. 4) just as the determining means understood as a software functionality, all of which have been identified as mere software-based entities; which implies that these can only be realizable only if a computer were provided. However, the 'computer system' is not explicitly **including** a computer or processor hardware, in order for one to ascertain whether any computer executing the merging/determining means as disclosed is **really part of** the 'system'; thus, the system claim is still devoid of any hardware support or tangible apparatus to carry out or realize the functionality of any software entity being claimed, as set forth in the Guidelines as follows.

The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result. The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101. http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

Mere reciting of software entities amounts to not belonging to any of the 4 statutory categories of subject matter. Further, because of the absence of explicit inclusion in the system claim of actual hardware support or tangible embodiment thereof, the claim is perceived as unable to realize the software functionality; i.e. to yield a tangible result, or being unable to yield a practical real world result. Claim 21, for mere listing of "Functional Descriptive Material" (see Annex IV of the Guidelines101.pdf, pg. 52-54) is therefore rejected as non-statutory by virtue of the Guidelines; hence claim 21, along with claims 22 is also rejected as non-statutory

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-10, 15-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Crystal Decisions, 'Report Designer Component 9', Creating a RDC Deployment Package, 5/14/2000, pp. 1-17

<http://resources.businessobjects.com/support/communitycs/TechnicalPapers/rdc9_deployment.pdf> (hereinafter Rdc_9)

As per claim 1, Rdc_9 discloses a method for deployment of components, comprising:
defining dependencies by components of pluggable component-based software (e.g. *Runtime files*, pg. 2; Crystall DLLs, Other DLLs , pg. 2-3; *Dependency files* – pg. 6-7), wherein at least one component of a deployable bundle is provided by a third party (e.g. *Visual Studio Installer ... Microsoft DLLs*, pg. 2, top; *Crystal Decisions ... support site*, pg. 3);
generating, by a cooperating interface (e.g. Visual Studio Installer, pg. 4), a list of defined dependencies (e.g. steps 1-3, pg. 5; step 3-4, pg. 5; Merge Modules, *Rdcruntime.msm ... contains the ... files, expose ... a License Key*– pg. 6, top half; *Runtime.chm ... which files need to be added to your VB ... package* - pg. 11);
identifying, by the cooperating interface (Visual Studio Installer, pg. 4-5), files associated with the list of defined dependencies (e.g. steps 1-3, pg. 5; step 3-4, pg. 5; Merge Modules, *Rdcruntime.msm ... contains the ... files, expose ... a License Key*– pg. 6, top half); and
processing, by the cooperating interface, the dependency list of defined dependencies and identified files to generate the deployable bundle (e.g. *add any additional files, make additional changes* – pg. 5; step 6 pg. 7; *Set up Wizard*, steps 6-7, pg. 9; pg. 13) and deploying the deployable bundle (*distribute it to your client* – pg. 5 bottom).

As per claim 2, Rdc_9 communicating deploying the deployable bundle to a cooperating environment (e.g. pg. 4; pg.7, pg. 9, pg. 10 – Note: Microsoft Visual installer reads on cooperating interface for receiving bundle data of new project to install).

As per claim 3, Rdc_9 discloses merging (Method 1: merge modules, pg. 1-6) the dependency list, the identified files, and default component elements to generate the deployable bundle (refer to claim 1; *required ... modules*, step 3, pg. 5).

As per claim 4, Rdc_9 discloses scanning the components to identify default elements (e.g. step 3, pg.5; *required ... modules*, step 3, pg. 5; *Craxddrt9.dep*, step 1, 6, pg. 6-7) and non-default elements (e.g. *Mdac.msm ... not always required* – pg. 5; *inform the user that they need to upgrade* – NOTE, pg. 5; *Add Extra Files* pg. 13).

As per claim 5, Rdc_9 discloses providing an installer component (step 7, pg. 9; step 3, pg.10; step 2, pg. 12; *.msi file* - pg. 15-16; *Output file Name, Output Folder* , pg. 16) for inclusion in the deployable bundle.

As per claims 6-7, Rdc_9 discloses validating the deployable (*Mdac ... will inform the user that they need to upgrade* – pg. 11; *Report Creation API ... prompted to insert the required licence* – pg. 12; *This file cannot be registered* – pg. 15, top); providing configuration files (e.g. *Readme.txt* pg. 3) for inclusion in the deployable bundle.

As per claim 8, Rdc_9 discloses merging the dependency list, the identified files, and default component elements to generate the deployable bundle (refer to claim 1- Note: RDC Deployment package using VS installer and Method 1, Method 2, Method 3- pg. 4--pg. 11 reads on merging list, and files and default components into a final installer package – see claims 3-5).

As per claim 9, Rdc_9 discloses providing a merge module (e.g. steps 1-3, pg. 5; step 3-4, pg. 5; *Merge Modules, Rdcruntime.msm ... contains the ... files, expose ... a License Key*– pg. 6, top half) for performing the merge of the dependency list, the identified files, and default component elements to generate the deployable bundle (refer to claims 3-5).

As per claim 10, Rdc_9 discloses a computer readable storage medium having computer readable instructions for:

defining dependencies by components of pluggable component-based software, wherein at least one component of a deployable bundle is provided by a third party;

generating, by a cooperating interface, a list of defined dependencies;

identifying, by the cooperating interface, files associated with the list of defined dependencies;

processing, by the cooperating interface, the dependency list of defined dependencies and identified files to generate the deployable bundle; and

deploying the deployable bundle;

all of which having been addressed correspondingly in claim 1.

As per claim 15, Rdc_9 discloses a computer system having a processor configured to deploy a package having dependencies comprising:

dependency data representative of the dependencies of components of the package (e.g. *Runtime files*, pg. 2; *Crystall DLLs*, *Other DLLs*, pg. 2-3; *Dependency files* – pg. 6-7),

the package comprising pluggable component-based software, wherein at least one component of a deployable bundle is provided by a third party (refer to claim 1); and

a merge module to merge the dependency data (e.g. steps 1-3, pg. 5; step 3-4, pg. 5; *Merge Modules*, *Rdcruntime.msm ... contains the ... files, expose ... a License Key*– pg. 6, top half; *Runtime.chm ... which files need to be added to your VB ... package* - pg. 11) with the components of the package to generate the deployable bundle (e.g. *add any additional files*,

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make additional changes – pg. 5; step 6 pg. 7; Set up Wizard, steps 6-7, pg. 9; pg. 13; distribute it to your client – pg. 5 bottom – refer to claims 3-5).

As per claim 16, Rdc_9 discloses comprising an installer, the installer (refer to claim 5; e.g. *.msi file* - pg. 15-16; *Output file Name, Output Folder* , pg. 16) being merged by the merge module to generate the deployable bundle.

As per claims 17-18, Rdc_9 discloses further comprising configuration information (refer to claim), the configuration information being merged by the merge module to generate the deployable bundle;

default package components (refer to claim 4), the default package components being merged by the merge module to generate the deployable bundle.

As per claim 19, Rdc_9 discloses communication means for use in communicating the deployable bundle to a cooperating computing environment (pg. 15-16 – Note: GUI interface to communicate with user – see pg. 3, 10, 14 - as means for adding and finalizing the installer reads on means use in communicating deployable to a cooperating environment operable via a computer user).

As per claim 20, refer to claim 6.

As per claim 21, Rdc_9 discloses a computer system for use in the deployment of components having dependencies comprising a means, each for:

determining the dependencies of components of pluggable component- based software (see GUI interface to communicate with user – see pg. 3, 10, 14), wherein at least one component of a deployable bundle is provided by a third party (e.g. *Visual Studio Installer ... Microsoft DLLs*, pg. 2, top; *Crystal Decisions ... support site*, pg. 3), the components defining

the dependencies (e.g. Crystall DLLs, Other DLLs , pg. 2-3; *Dependency files* – pg. 6-7) to the means for determining;

merging the determined dependencies of the components with the components of the pluggable component-based software (steps 1-3, pg. 5; step 3-4, pg. 5; *Merge Modules*, *Rdcruntime.msm ... contains the ... files, expose ... a License Key*– pg. 6, top half; *Runtime.chm ... which files need to be added to your VB ... package* - pg. 11) to generate the deployable bundle (refer to claim 9).

As per claim 22, refer to claim 9.

Response to Arguments

6. Applicant's arguments filed 5/02/08 have been fully considered but they are not persuasive. Following are the Examiner's observations therefor.

Declaration under 37 CFR § 1.131:

(A) Applicants have submitted that the subject matter of the claimed invention was conceived prior to May 14 2003 and that diligent work has been provided up to June 20, 2003, date of the constructive reduction to practice. This attests to the fact that diligent work has to be established via facts according to MPEP § 1.131(b):

- (b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

According to the exhibit provided as (i) 'DTS Deployment' and (ii) 'Implementation of deployment executable', following are how these documents are given weight.

As for document (ii), the mere layout being documented to describe how a deployment of packages would have to be done does not constitute a time-based listing of diligent work done by the inventive entity that reasonably conveys actual code development (or implementation task) instances with specific time/date for each (emphasis added) so to show how this work or task is mostly sustained and/or does not exhibit any let up in time between prior to May 14 2003 (emphasis added) up until date of constructive reduction to practice.

As for document (i), this amounts to a draft having a table of contents describing how the 'deployment' of package referred to as DTS project can be approached from its goals, scenarios, to detailed levels of deployment, and cookbook. This appears to be a written up theoretical depiction which is not sufficient to establish 'character and weight' expected for the diligent work requirement; that is, a conception followed by(emphasis added) factual evidences showing that dated work was sustained within a timeframe in terms of: a) not only was the amount of work (or implementation tasks thereof) actually taken by the inventive entity; but also b) daily distributed in a more or less continuous manner between prior to 5/14/03 up to 06/20/03.

The providing of evidence is deemed insufficient to convincingly establish factual diligent work required so to support the inventor's conception as this has been declared as prior to May 14, 2003.

The above affidavit-based declaration is dismissed, and the RDC_9 reference remains qualified as prior art applicable in the Office Action grounds of rejection.

35 USC § 102 Rejection:

(B) Applicants submitted that the 37 CFR 1.131 via proper supporting copies is deemed sufficient to disqualify the RDC_9 reference, and that the PTO-892 should be corrected to reflect

a correct date regarding RDC_9 effective prior date. The declaration is deemed insufficient as set forth above; and a duplicate copy of this PTO-892 will be effectuated.

In all, the claims stand rejected as set forth in the Office Action.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (571) 272-3735. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis Bullock can be reached on (571)272-3759.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3735 (for non-official correspondence - please consult Examiner before

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using) or 571-273-8300 (for official correspondence) or redirected to customer service at 571-272-3609.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tuan A Vu/

Primary Examiner, Art Unit 2193

July 08, 2008